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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,756	12/12/2001	Hyung-Chul Kim	678-690 (P9687ST/2)	8686
28249	7590	10/04/2006	EXAMINER	
DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/020,756

Applicant(s)

KIM, HYUNG-CHUL

Examiner

DANIEL LASTRA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/22/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/27/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-11 have been examined. Application 10/020,756 (METHOD FOR DISPLAYING ADVERTISEMENT USING SHORT MESSAGE SERVICE IN A PORTABLE MOBILE TERMINAL) has a filing date 12/12/2001 and foreign priority 12/30/2000.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Said claims recite "a method for reducing a call fee", however, Applicant's specification is not enabling in describing how a mobile subscriber would receive a reduce call fee. Applicant's specification only mentions displaying advertisements in a mobile terminal without describing how said displaying would cause a reduce of call fee to said mobile terminal users.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Claim 6 recite in line 11 "storing the received advertisement schedule data in the memory in a predetermined advertisement schedule data format". Said claim is indefinite because it does not describe in what memory said schedule data is stored. For purpose of art rejection, said limitation would be interpreted as storing schedule data in the memory of the mobile terminal.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Westling (US 2006/0041474).

Claim 1, Westling teaches:

A method for reducing a call fee by improving the efficiency of mobile communication by utilizing a short message service (SMS) in a portable mobile terminal to display an advertisement, comprising the steps of:

receiving and storing advertisement data and advertisement schedule data from an SMS-based advertisement service provider (see paragraphs 41-45, 32-34); and

displaying on a portable mobile terminal the advertisement data according to the advertisement schedule data (see paragraphs 32-34).

Claim 2, Westling teaches:

The method as claimed in claim 1, further comprising the steps of  
accessing a server of the SMS based advertisement service provider to select a  
desired advertisement and a desired advertisement time (see paragraph 32-34; 41-45);  
and

sending a phone number of the portable mobile terminal to the server for  
subscribing the SMS advertisement service (see paragraph 25).

Claim 3, Westling teaches:

The method as claimed in claim 1, wherein an SMS message includes an  
advertisement identifier (Ad 1D) indicating that the SMS message is an advertisement  
message (see paragraphs 41-45).

Claim 4, Westling teaches:

The method as claimed in claim 1, wherein the advertisement schedule data  
comprises:

start time information of the advertisement; expiration time information of the  
advertisement (see paragraphs 32-34); and

display day information of the advertisement (see paragraphs 32-34).

Claim 5, Westling teaches:

The method as claimed in claim 4, wherein the advertisement schedule data  
further comprises:

rotation time information of the advertisement (see paragraphs 32-34); and

display duration time information of the advertisement (see paragraphs 32-34).

Claim 6, Westling teaches:

A method for providing an advertisement using an SMS service in a portable mobile terminal, comprising the steps of

accessing a server of an SMS-based advertisement service provider to select at least one desired advertisement and at least one desired advertisement time and to input a phone number of the portable mobile terminal for receiving data related to a selected advertisement (see paragraphs 25, 41-45);

receiving the selected advertisement data and an associated advertisement schedule from the server (see paragraphs 41-45);

storing the received advertisement data in a memory of the portable mobile terminal in a predetermined advertisement data format (see paragraph 41); and

storing the received advertisement schedule data in the memory in a predetermined advertisement schedule data format (see paragraphs 41-45).

Claim 7, Westling teaches:

The method as claimed in claim 6, further comprising:

displaying the selected advertisement data according to the advertisement schedule data and returning to an initial screen mode after displaying the advertisement for a specified time according to the advertisement schedule data (see paragraphs 32-34).

Claim 8, Westling teaches:

The method as claimed in claim 6, where the advertisement schedule data comprises start and expiration day information for the advertisement, display day

information for the advertisement, and display duration time information for the advertisement (see paragraphs 32-34).

Claim 9, Westling teaches:

The method as claimed in claim 8, further comprising a rotation time information for the advertisement schedule data if the selected advertisement time overlaps with at least one other selected advertisement time (see paragraphs 32-34).

Claim 10, Westling teaches:

The method as claimed in claim 9, further comprising the step of alternatively displaying at least two advertisements in rotation according to the rotation time information (see paragraphs 32-34).

Claim 11, Westling teaches:

A method for displaying an advertisement using an SMS service in a portable mobile terminal, comprising the steps of

(a) checking an advertisement identifier (Ad ID) of a received message to determine whether the received message is an advertisement message (see paragraphs 44-45);

(b) parsing, if the received message is found to be an advertisement message, advertisement data from advertisement schedule data and storing the parsed advertisement data and advertisement schedule data in a memory (see paragraphs 41-45);

(c) utilizing the stored advertisement schedule data to determine whether to insert scheduled advertisement data into a display list (see paragraphs 32-34);

(d) checking the advertisement schedule data to determine whether to delete expired advertisement data from the display list (see paragraphs 32-34); and

(e) determining and displaying the advertisement data in the display list according to the advertisement schedule data (see paragraphs 32-34).

**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Cohen teaches an advertising method for wireless network.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
September 23, 2006

  
RETTA YEHDEGA  
PRIMARY EXAMINER